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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,135	07/30/2003	Siani Lynne Pearson	B-5196 621146-3	1838

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EXAMINER	
LEMMA, SAMSON B	

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,135	PEARSON ET AL.	
	Examiner	Art Unit	
	Samson B. Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/03 & 07/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-35** have been examined.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119 (a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 16** is rejected under 35 U.S.C. 101 because the subject matter is directed to non-statutory subject matter.

5. **Claim 16** is directed **a computer program for causing a programmable data processor execute the method of any of claims 1,14 and 15**. The examiner asserts that the limitation of the claim raises a question as to whether or not the program is stored on an appropriate medium and perform the function recited on the body of the respective claims when the program is read and executed by the computer. The claim does not clearly establish a statuary category of the invention. Therefore the claim is a program per se and does not fall within the statutory classes listed in 35 USC 101. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which

would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 13-14 and 34-35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 13-14 and 34-34**, recite the limitation "standard". "Standard's" are subjected to change due time and "TCPA" could have different standard at different time. Therefore, It has to be defined or replaced with another limitation in order to avoid ambiguity. For the purpose of examination, the limitation standard is not taken into account.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-35** are rejected under 35 U.S.C. 102(b) as being anticipated by **Jonathan Trostle** (hereinafter refereed as **Trostle**) (U.S. Patent No. 5,919,257)

10. **As per independent claims 1, 14-15, 17, 23 and 35 Trostle discloses a method of validating the performance of a participant in an interactive computing environment, [Abstract] comprising**
Issuing a first challenge to a participant's computing device to determine whether the participant's computing device is trustworthy, [column 7, lines 57-59] (the server issues a first challenge by sending a trusted hash value that is expected to be generated at the participants computing device or workstation to a participant's computing devices or workstation by hashing selected executable program resident in the workstation if the selected executable programs have not been unauthorizedly changed this inherently implies that the step is done for the purpose of determining the trustworthiness of the workstation.) **And if it is then issuing a second challenge to test the integrity of an application run on the participant's computing device, [column 7, lines 61-62]** (The server then issues a second challenge to the workstations/**participant's computing device** by sending a list of selected executable programs resident in the workstation to test the integrity of an application run on the workstation or the participants computing device)
And then making a decision concerning the participant's involvement in the computing environment. [Column 7, lines 63-67] (The participant's/ workstations receives a second challenge of list of the selected executable programs resident in the workstation; then the workstation hashes the selected executable programs resident in the workstation to calculate a computed hash value. Finally the decision is made based on the comparison of said computed hash value to said

trusted hash value in order to detect illicit changes to the selected executable programs.)

11. **As per claims 2-4, 18-20 and 24-26, Trostle discloses a method as applied to claims above. Furthermore Trostle discloses a method, in which the second challenge tests for modification of the application.** [Column 7, lines 63-67] (receiving a list of the selected executable programs resident in the workstation; hashing the selected executable programs resident in the workstation to calculate a computed hash value; and comparing said computed hash value to said trusted hash value in order to detect illicit changes to the selected executable programs;)

12. **As per claims 5-8, 21-22 and 27-28 Trostle discloses a method as applied to claims above. Furthermore Trostle discloses a method, in which in the first challenge the trustworthiness of the BIOS is validated**. [Column 7, lines 28-33 and figure 1] [Referring again to FIG. 4, in step 89 the workstation compares a computed hash value against the trusted hash value. If the values are equal then illicit changes have not been made to the selected executables programs, and execution continues with step 90 which returns workstation execution to the system BIOS.)

13. **As per claims 9-13,16, 29-34 Trostle discloses a method as applied to claims above. Furthermore Trostle discloses a method, in which the challenge is issued by a server [figure 1, ref. Num "12"] with which the participants computing device [figure 1, ref. Num "14-16] is in communication. [figure 1, ref. Num "18"]** [column 7, lines 57-59] (the server issues a first challenge by sending a trusted hash value that is expected to be generated at the participants computing device or workstation to a participant's computing devices or workstation by hashing selected executable program resident in the workstation if the selected executable programs have not been unauthorizedly this inherently implies that the step is done for the purpose of

determining the trustworthiness of the workstation. Then the participant's computer/ workstation receives a second challenge of list of the selected executable programs resident in the workstation; then the workstation hashes the selected executable programs resident in the workstation to calculate a computed hash value. Finally the decision is made based on the comparison of said computed hash value to said trusted hash value in order to detect illicit changes to the selected executable programs.)

14. **Claims 1-35** is also rejected under 35 U.S.C. 102(b) as being anticipated by **Rothrock, Lewis (**hereinafter refereed as **Rothrock**) (European publication No. WO 01/0137067 A1) (Publication Date: 05/27/2001) (Provided with IDS)

15. **As per claims 1-35 Rothrock discloses a method of validating the performance of a participant in an interactive computing environment, comprising issuing a first challenge to a participant's computing device to determine whether the participant's computing device is trustworthy, and if it is then issuing a second challenge to test the integrity of an application run on the participant's computing device, and then making a decision concerning the participant's involvement in the computing.** [See at least the abstract] (Secure linkage of first and second program modules so that they may authenticate each other and provide security for digital content accessed by one or more of the modules. The method includes storing at least one address of at least one function of the first program module in a file, calling the second program module by the first program module and passing the file to the second program module, verifying integrity by the second program module of the first program module, and calling, by the second program module, a selected function of the first program module using an address obtained from the file when integrity of the first program module is verified. In one embodiment, the first program module may be a digital content player application and the

second program module may be an integrity verification kernel for verifying the integrity of the player application. The file may be a signed binary description file including addresses of functions in the first program module.)

16. **Claims 1-35** is also rejected under 35 U.S.C. 102(b) as being anticipated by **Drake, Christopher** (hereinafter refereed as **Drake**) (European publication No. WO 97/04394) (Publication Date: 02/06/1997) (Provided with IDS)

17. **As per claims 1-35 Drake discloses a method of validating the performance of a participant in an interactive computing environment, comprising issuing a first challenge to a participant's computing device to determine whether the participant's computing device is trustworthy, and if it is then issuing a second challenge to test the integrity of an application run on the participant's computing device, and then making a decision concerning the participant's involvement in the computing.** [See page 6-9, Aspect 3, "detecting tampering" and Aspect 4, "Preventing execution-tracing"]

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax

phone number for the organization where this application or proceeding is assigned is 703-873-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA
S.L.
07/20/2006

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